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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,249	10/22/2003	Meng C. Hsieh	10390US01	5457

7590 10/24/2005

Attention: Eric D. Levinson
Imation Corp.
Legal Affairs
P.O. Box 64898
St. Paul, MN 55164-0898

EXAMINER

RESAN, STEVAN A

ART UNIT	PAPER NUMBER
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·1773

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/691,249	Applicant(s) HSIEH ET AL.	
	Examiner Stevan A. Resan	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 2-10, 17-24 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons of record.
3. Claims 1, 3, 5-7, 9-17, 19-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota et al. US 6037037 for the reasons of record.
4. Applicant's arguments filed 9 August 2005 have been fully considered but they are not persuasive.

Applicants traverse the rejection of claim 2 under 35 USC 112 second paragraph on the basis that the "Tg of the composite front side" is the combined Tg exhibited by the combined layers comprising the front side and is not an average of all the layers but a measurable quantity. However the examiner disagrees.

While the Tg may be measured, a range of several degrees may be observed between a thermal and mechanical measurement method e.g. DSC vs. viscoelastic methods. Furthermore measurement may reveal multiple glass transition temperatures for the layer especially with use of polyurethane resins (See Ohno US 6811855 Col 11 lines 48-63). Therefore one of ordinary skill in the art would NOT recognize the bounds of the claim even in light of the specification.

Applicants also traverse the rejection of the claims containing the terms "hard" and "soft" and argue that they are qualitative terms that establish the relative hardness of two resins in a layer and that in preferred embodiments the "hard" and "soft" resins

are further defined in terms of the glass transition temperatures exhibited by the respective resins. Applicants defend this nexus by asserting that an applicant may be his own lexicographer and to give terms uncommon meanings he must set out his uncommon definition in some manner within the patent disclosure.

However applicants have not defined what is a "hard" resin or "soft" resin or the distinguishing characteristics thereof. Even if the characteristic were a relative one, there is no objective way taught to determine the hardness or softness. Different methods may produce differing results due to any dilatent and thixotropic nature of the polymers. Furthermore the examiner cannot find where applicants have defined hard and soft in terms of the glass transition temperature. For example at page 6 of the specification, last paragraph : "The soft resin has a Tg of less than about 60 C" is not a clear definition that a soft resin is defined as one having a Tg of less than about 60 C. Applicants have carefully defined other terms in the specification on specification pages 3 and 4 and the omission is deemed prima facie evidence that a "hard" or "soft" resin is not defined by the Tg.

Applicants traverse the rejection under 35 USC 103 based upon Kubota on the basis that Kubota teaches a non magnetic layer containing non magnetic needle bodies. However any arguments based on this are not relevant since no claim is directed to this feature. Only the average length of the magnetic pigment particles are claimed.

Applicants also argue that the magnetic pigment particles of Kubota has a preferred major axis length of 0.05-0.2 microns while applicants claimed range is less than 75 nm. However the range of Kubota overlaps applicants' claimed range. However

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a prior art reference that discloses a range overlapping a somewhat narrower range is sufficient to establish a *prima facie* case of obviousness. In re Peterson, 315 F.3d 1325, 1330, 65 USPQ2d 1379, 1382-1383 (Fed. Cir. 2003).

Applicants assert that the examiner has failed to meet the burden of establishing a *prima facie* case of obviousness. However, the examiner disagrees and asserts that the burden has shifted to applicants.

If applicants are relying upon unexpected results when compared with the closest prior art, they have not fulfilled the requirement for side-by-side testing nor demonstrated that their claims were commensurate in scope with the evidence presented. The limited comparative data is hardly commensurate with the extensive class of compounds encompassed by the claims. In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983).

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is 571-272-1513. The examiner can normally be reached on Tues-Thurs from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached at 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


STEVAN A. RESAN
PRIMARY EXAMINER